

14303 (0901.68198)

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard J. Ernst
Serial No.: 10/687,451
Conf. No.: 8743
Filed: October 16, 2003
For: ROD HANGER FOR SECURING A
ROD TO A SUBSTRATE
Art Unit: 3632
Examiner: Epps, Todd Michael

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests a pre-appeal review of the outstanding final rejections of the pending claims as presented in the Final Action mailed on June 24, 2009 in this application based upon the attached remarks.

Respectfully submitted,
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September 24, 2009

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PRE-APPEAL BRIEF REQUEST FOR REVIEW REMARKS

An inadequate examination is demonstrated by the record of this prosecution including unsupported misrepresentations of the applied prior art. No genuine factual dispute is shown in the record. Requirements of the law of obviousness are not met. Fairness dictates that the rejections be withdrawn and the application allowed without subjecting applicant to the delay and expense of a full appeal in a case that has already had an extensive and costly six-year pendency. The Application should be allowed on pre-appeal because the rejections involve clear error, misrepresenting the art, no genuine factual dispute is raised by the unsupported allegations concerning the content of the cited references, and multiple inaccurate explanations of the art do not show a factual dispute.

In the Final Action mailed on June 24, 2009, claims 1-2, 8, 12, 26, 33-34 and 37 are rejected as obvious over Logue in view of Jones and in further view of Farrell. Claims 32, 35 and 36 were rejected as obvious over Logue in view of Jones and further in view of Gutshall. These rejections are improper. For the sake of brevity, only the impropriety of the rejections of claims 32 and 35-39 are argued herein. Applicant reserves the right, however, to argue rejections of additional of the claims in subsequent submissions.

A. THE OBVIOUSNESS REJECTION OF CLAIMS 32, 35 AND 36 IS IMPROPER: GUTSHALL FAILS TO DISCLOSE OR SUGGEST THE RECITED RESILIENT COVER

It is submitted that no *prima facie* case of obviousness has been put forth with regards to claims 32, 35 and 36 which are rejected as obvious over Logue in view of Jones and further in view of Gutshall. Claims 35 and 36 are independent, and claim 32 depends from claim 36. Among other elements, each of these claims requires at least four anti-rotation elements configured for penetratingly engaging a substrate that the fastener is driven into. Each of claims 32, 35 and 36 additionally require:

- a resilient cover formed of a polymer extending over the anti-rotation elements, said resilient cover secured to said anti-rotation members by one of a chemical adhesive or thermoforming (claim 35);
- a resilient cover for enhancing the adhesion of the mounting portion with the substrate (claim 36);
- the resilient cover (of claim 36) is formed of a polymer and extends fully over said anti-rotation member, and is secured to said anti-rotation members by one of a chemical adhesive or thermoforming (claim 32)

The Office Action admits that Logue and Jones fail to disclose these elements, but instead cites Guttshall: “Nevertheless, Guttshall ‘185 teaches wherein a mounting is secured by a resilient cover;” and “... Guttshall ‘185 discloses wherein the resilient cover is secured by a chemical bonding adhesive – a liquid bonding agent.” It is submitted that this is incorrect. Careful review of Guttshall fails to disclose any fastener having a resilient cover, a resilient cover attached using a chemical adhesive, or other claimed elements of claims 32, 35 and 36.

Guttshall only discloses a fastener such as metal screw, a separate rigid washer 18, and a separate resilient seal washer 30 which may be made of rubber or the like. Col. 5, lines 4-15; Col. 5, lines 26-35. As best understood, the subject invention of Guttshall operates wherein the resilient washer is deformed to seal a hole into which the fastener is driven. Summary of the Invention. Guttshall does not disclose or suggest, however, that any of its elements are “covered” with a resilient cover or other claimed elements. Finally, it is noted that the Final Action fails to cite any particular portion of Guttshall by column, line, or Figure. It is suspected, however, that the Final Action cites the resilient seal washer 30. Clearly, this cannot satisfy the claimed elements since it is a distinct and separate piece – it is not a cover secured to anything by a chemical adhesive or bonding.

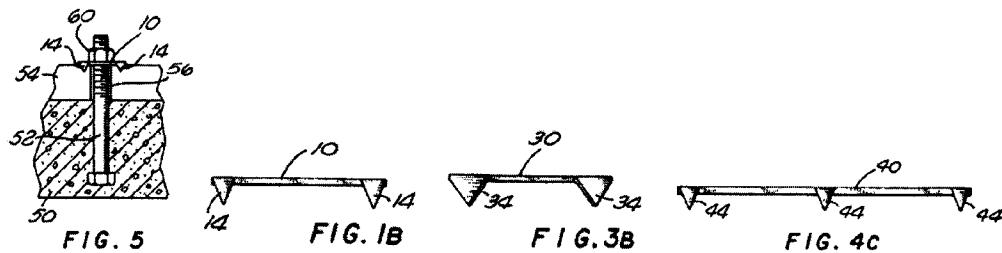
B. THE SHARP POINTED GRIPPER PRONGS OF THE ‘723 PATENT DO NOT HAVE THE REQUIRED HEMISPHERICAL SHAPE OF THE ANTI-ROTATION ELEMENTS OF CLAIMS 37 AND 38, AND IN FACT TEACH AWAY FROM THIS CLAIMED STRUCTURE.

The MPEP states that a *prima facie* case of obviousness requires, among other things, objective evidence which establishes a teaching to modify the prior art reference components to construct a device substantially equivalent to that claimed. MPEP §§2141, 2143. The Examiner must set forth a rationale, supported by objective evidence that the prior art at the time of invention provided a teaching to modify the prior art reference components to achieve the claim at issue. *Id.* The MPEP also warns against overly broad findings of obviousness based on the impermissible use of hindsight, and that it is impermissible to use hindsight gained from considering the application. *Id.* The MPEP and legal precedent also make clear that there can be no motivation or suggestion to combine the references: “If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP 2143.01.V (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). It is improper to combine references where the

references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, (Fed. Cir. 1983) see also MPEP 2141.02.

Considering the above, the obviousness rejections of claims 37 and 38 are improper. Claim 37 depends from claim 1 and claim 38 from independent claim 36, and each recite that the anti-rotation elements have a generally hemispherical shape. Both are rejected as obvious over Logue in view of Jones (claim 38 in further view of Guttshall). The Final Action admits this structure is not disclosed by the '723 patent, but suggests that it represents only an obvious variation in shape over the disclosure. It is submitted that this is not correct, and that the '723 patent not only fails to teach these shapes but further teaches away from them.

The '723 patent teaches that its gripper prongs 14 are "...*formed with a sharp point* so as to pass into and grip the wood sill ..." Col. 2, lines 58-59 (emphasis added). Each of FIGS. 5, 1B, 3B, 4C, and others likewise consistently illustrate gripper prongs 14, 34 and 44 (respectively) as having thin shapes with sharp points:



The '723 patent further teaches that the gripper prong sharp points are important to the intended purpose of its invention. The '723 patent is directed to reinforcing plates for use on a wood sill (e.g., of a building frame) to provide a reinforced anchoring location for receiving an anchor bolt protruding from a concrete foundation. Abstract, Col. 2, lines 57-60. Frame residential houses are typically tied to their foundation by attaching a lowermost wood sill of the house frame to foundation anchor bolts. Col. 1, lines 8-12. In earthquake conditions, the house is held to the foundation only through attachment to these bolts. Col. 1, lines 26-30. A problem of the prior art occurred under earthquake conditions which caused a foundation (and its anchor bolts) to shift. As the anchor bolts shift they could slice through the house's wood sill, causing the building to break free from the foundation. Id.

The '723 patent addresses this problem through use of reinforcing plates having gripper prongs **with sharp points** to slice into and firmly grip opposite sides of the wood sill. Summary of the Invention, Col. 1, lines 45-49. The foundation anchor bolt is received through a plate

central opening 22. Col. 2, lines 62-66. If the anchor bolt shifts during earthquake, the bolt will then engage the edge of the reinforcing plate opening 22 instead of the wood sill sidewall. Summary of the Invention, Col. 2, lines 4-30. The '723 patent teaches that this configuration results in a much improved load transfer from bolt to wood that reduces risk of the wood sill splitting. Col. 2, lines 18-30.

The '723 patent specifically teaches that the sharp-pointed gripper prongs 14 improve over configurations that introduced "crushing" engagement with the sill: "... Standard washers need to crush down into the wood to restrain whereas the present invention does not ... since the gripper prongs transfer the load." Col. 4, lines 28-33. Accordingly, the thin blade-like shape and sharp points on the gripper prongs of the '723 patent are important to the intended purpose of its invention: to firmly anchor the plate in the sill by slicing into it while avoiding "crushing" engagement that can result using washers or the like. One considering the '723 patent would therefore not be led to the shapes required by claims 37 and 39: a generally hemispherical shape.

The claimed hemispherical shapes do not have the "*sharp point*" that the '723 patent teaches is important to its gripper prongs. Further, the claimed hemispherical shape would be expected to provide reduced gripping power of the wood sill verses the sharp pointed gripper prongs 14, and further would be expected to apply some crushing engagement on the wood sill as they were forced downward into it (due to their shape and lack of a sharp point). The '723 patent expressly teaches away from such engagement. Col. 4, lines 28-33. For these reasons it is submitted that the '723 patent fails to disclose or suggest the hemispherical shaped anti-rotation elements of claims 37 and 38, and in fact teach away from the claimed structure. The obviousness rejections of claims 37 and 38 must therefore be reversed.

Finally, it is noted that the ground of this rejection were previously put forth to reject the same elements of other claims but was subsequently withdrawn (see, for example, the Appeal Brief filed on November 27, 2007). It is submitted that making this rejection once again is therefore inconsistent with prior prosecution and does not further prosecution.

C. CLAIM 37 IS DEFINITE

Claim 37 has been rejected as indefinite under §112, second paragraph. Claim 1 recites that the anti-rotation elements have one of a generally hemispherical or a truncated cone shape. Claim 37 depends from claim 1 and recites that the elements have a generally

hemispherical shape. The Final Action states: "Claim 37 is rejected to (sic) because it is not clear which shape of anti-rotation element as applicant is now claiming a generally hemispherical shape. As previously rejected, the Examiner used a generally truncated hollow cone shape in the previous action." Page 2. This rejection is not clear, is not well-founded, and is improper. It is submitted that claim 37 is definite.

D. CLAIM 39 HAS BEEN IMPROPERLY WITHDRAWN

Claim 39 depends from claim 1 and recites that the anti-rotation elements have been formed by stamping wherein they have a closed end. The Final Action indicates that claim 39 is directed to a patentably distinct invention and has been withdrawn from consideration: "Newly submitted claim 39 is directed to an invention that is distinct from the invention originally claimed for the following reasons: applicant is trying to further recited anti-rotation elements are formed by stamping, which is not found in the specification." It is submitted that stamping is disclosed in the specification in several of the FIGS. and on pages 8-9, among other locations. This withdrawal from consideration is therefore improper and that claim 39 must be considered.

E. CONCLUSION

Applicant asks that this pre-appeal review request be sustained, and the application allowed. As no sufficient rejections have been established, the costly six-year pendency of this application should be ended with the issuance of notice of allowance.

Respectfully submitted,

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